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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,857	03/08/2004	Andreas Schuch	032301.371	1268

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EXAMINER

RAETZSCH, ALVIN T

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/795,857

Applicant(s)

SCHUCH ET AL.

Examiner

Alvin T. Raetzsch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 12-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/8/04; 7/6/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1, drawn to a process of making carbon black, classified in class 23, subclass 314.
 - II. Claims 2-11 & 18-21, drawn to a carbon black product, classified in class 423, subclass 449.1.
 - III. Claims 12-17, drawn to a process of making rubber, classified in class 524, subclass 495.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are ^{possibly} related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process could be used to make carbon black pellets with any range of properties.

3. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP § 806.05(h)). In the instant case the carbon black of group II could be used to make a different ~~material~~ composition than the one of group III, ^{such as}

4. ^{Ink.} Inventions I and III are two different processes of making. The inventions have different classifications and can be practiced independently of one another.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Robert Weilacher on 11/15/05 a provisional election was made with traverse to prosecute the invention of group II, claims 2-11 & 18-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 & 12-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is

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found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Specification

9. The abstract of the disclosure is objected to because it exceeds the minimum length of 150 words by a significant amount. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-4, 8, 10, 18, & 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Bush (US 5,236,992).

Klasen et al. teaches a carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

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Bush teaches carbon black pellets having a DBP of >100, a CDBP of >78, and a surface area of <70 m²/g (Table 3).

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Bush in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The intrinsic properties of the carbon black of Bush can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

Claims 8, 10, 18, & 20: Bush teaches using the carbon black pellets in rubber compositions for making hoses and belts.

12. Claims 5-7, 9, 11, 19, & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klasen et al. (US 5,480,626) in view of Vogler et al. (US 6,231,624).

Klasen et al. teaches a carbon black pellets that have a hardness of 10-50 grams (Claim 7d), an average diameter between 0.5 and 4 mm and a suitable diameter range (Claim 7a-b), and pre-dried moisture contents of 43-52% (Table 1).

Vogler et al. teaches carbon black pellets having a DBP of 46, a CDBP of 44, and a surface area of 45 m²/g (Table 1, CB 5). Vogler teaches a hardness and average particle size slightly lower than claimed.

Klasen states that carbon blacks with properties in the range of 40-450 DBP and surface areas of 30-1200 are suitable for the disclosed pelletizing process. It therefore

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would have been obvious to someone of ordinary skill in the art to use the carbon blacks taught by Vogler in the process taught by Klasen in order to achieve a carbon black pellet with specific properties. The intrinsic properties of the carbon black of Vogler can be used to create a pellet with the extrinsic properties taught by Klasen in order to create a pellet with good flowability and dispersability.

Claims 9, 11, 19, & 21: Vogler teaches using the carbon black pellets in rubber compositions. It is well known in the art to use such rubber compositions in articles such as tires, belts, and hoses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin T. Raetzsch whose telephone number is 571-272-8164. The examiner can normally be reached on 9-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alvin T Raetzsch



STUART L. HENDRICKSON
PRIMARY EXAMINER